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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,829	06/23/1999	HIROSHI SUZUKI	1576.77	2131

7590 05/29/2003

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/29/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/331,829

Applicant(s)

SUZUKI ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 and 30-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

This application contains claims 25-28 and 30-34 drawn to inventions nonelected with traverse in Paper No. 30. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144).

See MPEP § 821.01.

The 35 U.S.C. 112, first paragraph rejection is rescinded due to the replacement of the non-enabled "non-curing epoxy resin" with the phrase "epoxy resin prior to cure" in independent claims 23 and 29.

The concession on page 13, the fourth paragraph of the amendment filed March 19, 2003 (Paper No. 33) that the claimed characterization of the tetrakisphenol compound of general formula (I) of claim 23 as a "curing accelerator catalyst" is synonymous with the tetrakisphenol compound as a curing catalyst as described in the specification overcomes this aspect of the aforementioned 35 U.S.C. 112, first paragraph, rejection.

The 35 U.S.C. 102(b) or 103(a) rejection over the Schreiber et al. patents, Koike et al. or Dewhirst is withdrawn due to the incorporation of the content of tetrakisphenol of claim 24 into independent claim 23 as suggested on page 7, lines 7-9 of the Office action mailed February 18, 2003.

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The text of section 102(b) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Zupancic et al.

The rejection is maintained for the reasons of record set forth in the previous Office action. The arguments filed March 19, 2003 have been considered but are unpersuasive.

Zupancic et al. employs tetraphenolethane in an amount of 0.03 mole per mole of epoxy group which is embraced by the claimed range of from 0.001 to 0.1. Although the tetraphenolethane is designated as a chain extender, its use in an equivalent proportion within an equivalent composition comprising an epoxy resin and curing agent does not differentiate it from the function of the claimed tetrakisphenol as a curing accelerator catalyst. It is admitted on page 14, the third paragraph of the specification that "the tetrakisphenol compound that forms the said clathrate is a compound that is conventionally known as an addition-type curative."

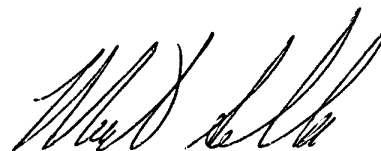
The function of the tetraphenolethane of Zupancic et al. is not confined to its performance as a chain-extender, especially considering the use of a quantity well within the claimed parameters. Example 38 (col. 22) does not react the tetraphenolethane until the epoxy resin is blended with both the tetraphenolethane and N-benzyl-dicyandiamide curing agent. Thus, the tetraphenolethane is available to chain-extend and participate in the curing of the epoxy resin equivalent to its presence in an equivalent level within the claimed composition.

Zupancic et al. does not recite the tetrakisphenol of claim 28 which acts as the host compound enveloping a curing agent as denoted by the term "clathrate."

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(703) 308-2399 (Fax no. (703) 872-9311)  
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers  
Primary Examiner  
Art Unit 1712

rs  
5/28/03